U. S. Circuit Court for the Southern District of New York

Eldridge R. Johnson	) In Equity on
versus	) Patents
The Universal Talking Machine Company	) 655,556 &) 655,557
	No. 7606

PARTIAL RECORD, 1900 - 1902

U. S. Circuit Court. Southern District of New York.

Eldridge R. Johnson	)	In Equity
	)	on Patents
versus	)	655,556 &
	)	655,557
The Universal Talking Machine Company	)	No. 7606

PARTIAL RECORD, 1900 - 1902

IN THE CIRCUIT COURT OF THE UNITED STATES

FOR THE Southern DISTRICT OF New York NIA.

ELDRIDGE R. JOHNSON

vs.

Universal Talking Machine Company IN.

IN EQUITY.

October Sessions, 1900.

No. 13

Answer.

WALDO G. MORSE,

Solicitor for Defendant,

Office and P. O. Address,

135 BROADWAY,

New York City.

In the Circuit Court of the United States

FOR THE Southern DISTRICT OF New York.

ELDRIDGE R. JOHNSON

vs.

Universal Talking Machine Company.

In Equity.

The answer of Universal Talking Machine Company ... N, defendant, to the bill of complaint of ELDRIDGE R. JOHNSON, complainant.

This defendant answering the said complainant's said bill of complaint, says:

This defendant admits that it is a corporation organized and existing under the laws of the State of New York and doing business in and having a regular and established place of business in the City of New York ... within the said Southern District of New York ... And this defendant further admits that the complainant Eldridge R. Johnson is a citizen of the United States and a resident of the City of Philadelphia in the State of Pennsylvania.

1

This defendant, in answer to paragraph 1 of the said Bill of Complaint, denies that the said Eldridge R. Johnson invented improvements in Sound Recording

and Reproducing Machines as alleged in said Bill; and denies that the same involved an inventive act, or that the said Johnson was the original or the first or the sole inventor or producer thereof; and denies that the same were either new or useful at the date of his alleged invention; and denies that the same were—or any part thereof was—patentable, affirming that the same were and was merely an aggregation of old and well known elements operating in an old and well-known manner; and this defendant further denies that the said alleged improvements were not known or used by others in this country before the alleged invention thereof by the said Johnson, or had not been patented or described in any printed publication in this or any foreign country before his alleged invention thereof; and denies that the said alleged improvements were not in public use or on sale in this country for more than two years prior to the date of his application for the grant of U. S. Letters-patent therefor, or that the same had not been abandoned.

2

As to the matters and things alleged in paragraph 2 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as he can.

3

As to the matters and things alleged in paragraph 3 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as he can.

4

This defendant admits that there issued on the 7th day of August, 1900, Letters-patent of the United States purporting to be granted to Eldridge R. John-

son and Thomas S. Parvin, bearing the number 655,556, and purporting to be for Improvements in Sound Recording and Reproducing Machines; however, this defendant is not advised save by the bill as to the remaining allegations in the said paragraph contained, and therefore leaves the complainant to make such proof thereon as he can; but this defendant expressly denies that by virtue of the premises the said Eldridge R. Johnson and Thomas S. Parvin became the sole owners of all rights and privileges granted and secured by the said Letters-patent and of all the rights in the premises, or of any rights and privileges whatever.

5

This defendant admits that there was issued on the 7th day of August, 1900, Letters-patent of the United States purporting to be granted to Eldridge R. Johnson, bearing the number 655,557, and purporting to be for Improvements in Sound Recording and Reproducing Machines; however, this defendant is not advised save by the bill as to the remaining allegations in the said paragraph contained, and therefore leaves the complainant to make such proof thereof as he can; but this defendant expressly denies that by virtue of the premises the said Eldridge R. Johnson, or anyone, became the sole owner of all rights and privileges granted and secured by the said Letters-patent and of all rights in the premises, or of any rights and privileges whatever.

6

As to the matters and things alleged in paragraph 6 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as he can.

7

As to the matters and things alleged in paragraph 7 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as he can.

8

As to the matters and things alleged in paragraph 8 of the bill, this defendant has no information save from said bill, and therefore leaves complainant to make such proof thereof as he can.

9

As to the allegations in paragraph 9 of the bill, touching complainant's title to the patents in suit, this defendant has no information save from the said bill, and therefore leaves complainant to make such proof thereof as he can ; but this defendant again denies that by virtue of the premises the complainant, or any one, has the exclusive right or any rights in the premises.

10

In answer to the allegations in paragraph 10 of the bill, this defendant is not informed, save by said bill, that the complainant or any one ever spent large sums of money or any sums of money in practicing said alleged inventions or improvements purporting to be patented in and by the said Letters-patent No. 655,556 and No. 655,557, and in introducing the same into public use ; and this defendant denies that the same or any substantial or material part thereof are or ever were of great commercial value or practical utility or of any value or utility whatever ; and denies that a great public interest or any interest has been manifested therein, or that a large demand or any demand has been created

for any apparatus constructed in accordance with or embodying the alleged improvements or any of them ; and as to what apparatus the complainant is ready and able to supply, this defendant is not advised save by the said bill of complaint, but upon information and belief avers that numerous suits in equity have been filed against this complainant seeking to enjoin him from the manufacture and sale of talking-machines and talking-machine supplies ; and this defendant further denies that the public generally, or any one, has ever recognized and acquiesced in the facts that the said Johnson was the first and original and sole inventor of the said alleged inventions and that the said patents or either of them were or are good and valid, or that the public or any one has also acknowledged the claims of this complainant to any rights under the said patents ; and this defendant further denies that save for the alleged infringements and wrongs by the said bill charged to be committed by this defendant, the complainant would be in peaceful enjoyment and possession of the said Letters-patent and of whatever income might be derivable therefrom, and that the owners of the said Letters-patent had never acquiesced in any alleged infringement of their alleged rights in the premises,—but in this regard this defendant shows upon information and belief that all persons familiar with the talking-machine art or engaged in the talking-machine business have long known that there is nothing novel or useful in the matters and things purporting to be covered by the claims of the said two Letters-patent, or by any claim thereof, and they have regarded with ridicule any claim on the part of this complainant to invention therein.

11

And in answer to paragraph 11 of the said bill, this defendant admits that it has dealt in talking-machines and appliances therefor relative to sound-recording and

reproducing ; but this defendaut expressly denies that any one of such articles ever had or contained or now has or contains any device or thing patented, or purporting to be patented, in and by any claim or claims of said Letters-patent No. 655,556, or of said Letters-patent No. 655,557 ; and this defendant further denies that any claim of either of said patents covers or purports to cover any "method" as intimated by the said paragraph 11 ; and this defendant denies that it ever contrived to injure this complainant or to deprive him of any benefits and advantages which might accrue to him from the said patents or from any source; and this defendant again denies that by virtue of the premises the exclusive rights or any rights have ever become vested in this complainant.

12

And this defendant expressly and positively denies each and every allegation in paragraph 12 of the said bill contained.

13

In answer to paragraph 13, this defendant has no information save by the bill as to any notice given to the public by the complainant, or as to any article being by him or by his authority marked "patented," together with the date of the grant of any patent, and therefore leaves the complainant to make such proof thereof as he can ; but this defendant expressly denies any knowledge of the said alleged notice.

14

And in answer to the allegations of paragraph 14, this defendant denies that it has ever made or sold or used any device or article or apparatus or thing having or containing any feature patented to this complainant,

or purporting to be patented to him, or the same in any material respect, as the articles and things purporting to be claimed in the said patents, or in either of them ; and this defendant further denies that it has ever made any gains or profits to which this complainant is entitled, or that this complainant was ever damaged or injured by any act of this defendant, or that this defendant has ever been requested by this complainant to desist from any alleged infringement; this defendant again denies that this complainant is by virtue of the premises possessed of all exclusive rights and privileges under and by virtue of the said Letters-patent, or of any rights and privileges whatever ; and denies that its actions are contrary to equity and good conscience ; and denies that there is any equity whatever in complainant's said bill of complaint.

15

And for a further defense, this defendant affirms that not one of the various matters and things and combinations disclosed by the said Letters-patent and by each of them, is or ever was the result of an inventive act ; and further affirms that each and every one of the same was not novel with the said Johnson, but on the contrary was well known in this country long before the alleged invention thereof by complainant, and had been in public use in this country for more than two years before the date of his application ; and that the claims in each of the said patents contained are for aggregations of old and well known features, and affirms that the same are not now and never were capable of any useful employment whatever, but on the contrary are and were inoperative.

16

And for a further defense this defendant shows, and the same is manifest from a comparison of the said

Letters-patent here sued on with the original applications and the proceedings thereon in the Patent Office, that the alleged improvements and inventions purporting to be covered by the claims of the said patents are substantially and materially different from those originally disclosed by the application and applications as originally filed; and the defendant, again insisting that there is no novelty whatever in any of the matters and things claimed in and by the said patents, affirms that if there be any novelty at all in the claims as allowed the same is found in the new matter thus unlawfully and unwarrantably introduced into the said applications during their pendency in the Patent Office; and that therefore the said patents are void and of no effect in law.

17

For a further defense this defendant avers, upon information and belief, that the said alleged inventions and each and all of them were not produced by this complainant alone, but were the joint product of one Alfred Corning Clark (then of Philadelphia, Pa., but now of Paris, France) together with this complainant; and that therefore the said patents are void and of no effect in law.

18

For a further defense this defendant avers, upon information and belief, that the said alleged inventions and each and all of them were not produced by this complainant alone, but were the joint product of one ---------- Reinhardt (then and now of Camden, New Jersey), together with this complainant; and that therefore the said patents are void and of no effect in law.

19

For a further defense this defendant shows that the matters and things purporting to be claimed by the patents in suit were fully disclosed and set forth, and were attempted to be claimed, in and by the various patents previously granted to the said complainant, either as sole patentee or conjointly with others, before the date of the issue of the patents here in suit, to wit, in U. S. Letters-patent No. 624,625, granted May 9, 1899, to the said Alfred Corning Clark and this complainant, upon a joint application filed Jan. 9, 1897, and in other patents granted in this country and in foreign countries, the dates and numbers of which are at present to this defendant unknown, but which it prays leave to introduce as part of this answer when ascertained; and that therefore the said patents are void and of no effect in law.

20

And for a further defense this defendant shows that by reason of having thus fully disclosed the said inventions in his said early patent and patents without claiming the same, the said Eldridge R. Johnson thereby abandoned the inventions purporting to be covered by the patents here sued on, and the same thereby became dedicated to the public; and therefore the said patents and each of them are void and of no effect in law.

21

And for a further defense to the said patent No. 655,557, this defendant avers that the matters and things purporting to be claimed thereby are fully disclosed in the said Letters-patent No. 655,556, and are attempted to be claimed thereby; wherefore the said Letters-patent No. 655,557 are void and of no effect in law.

22

And for a further and special defense, this defendant shows *First*, that for the purpose of deceiving the public the descriptions and specifications filed in the Patent Office by this complainant were made to contain less than the whole truth relative to his alleged invention or discovery, or more than is necessary to produce the desired effect; and that the claims and each of them are ambiguous and insufficient, and that the specifications and each of them are not in such full, clear, concise and exact language as to enable others skilled in the art to make, construct, and use the alleged improvements, and, therefore the said patents are void and of no effect in law.

23

And for a further and special defense, this defendand shows *Second*, that the said patents and each of them were surreptitiously and unjustly granted for that which was in fact the invention or production of another, or others, who was or were using due diligence in reducing the same to practice,—namely, the said Alfred Corning Clark, the said Reinhardt, Joseph W. Jones, of New York City, Louis P. Valiquet, of New York City, and others, whose names and addresses are to this defendant now unknown, but which when discovered this defendant prays leave to insert in this Answer; and that therefore the said patents are void and of no effect in law.

24

And for a further and special defense, this defendant shows *Third*, that each and all of the said alleged improvments were fully set forth and disclosed in and by the following Letters-patent of the United States, that is to say:

No. 227,679, granted May 18, 1880, to Thomas A. Edison;

No. 341,214, granted May 4, 1886, to Bell & Tainter;

No. 341,288, granted May 4, 1886, to Sumner Tainter;

No. 375,579, granted Dec. 27, 1887, to Sumner Tainter;

No. 386,974, granted July 31, 1888, to Thomas A. Edison;

No. 393,466, granted Nov. 27, 1888, to Thomas A. Edison;

No. 394,105, granted Dec. 4, 1888, to Thomas A. Edison;

No. 394,106, granted Dec. 4, 1888, to Thomas A. Edison;

No. 400,646, granted Apr. 2, 1889, to Thomas A. Edison;

No. 409,003, granted Aug. 13, 1889, to Gianni Bettini;

No. 409,005, granted Aug. 13, 1889, to Gianni Bettini;

No. 415,499, granted Nov. 19, 1889, to Louis S. Clarke;

No. 423,039, granted Mar. 11, 1890, to Thomas A. Edison;

No. 424,914, granted Apr. 1, 1890, to John H. White;

No. 440,155, granted Nov. 11, 1890, to Isaac W. Heysinger;

No. 450,740, granted Apr. 21, 1891, to Thomas A. Edison;

No. 454,947, granted June 30, 1891, to Wm. McMahon;

No. 500,281, granted June 27, 1893, to Thomas A. Edison;

No. 531,690, granted Jan. 1, 1895, to Stewart D. McKelvey;

No. 572,182, granted Dec. 1, 1896, to Ray;

No. 633,226, granted Sept. 19, 1899, to Adolph Betzold;

and the following German patent:

No. 82,934, granted Oct. 1, 1895, to Lahola & Sachs;

and others whose respective dates and numbers are to

this defendant now unknown, but which when ascertained it prays leave to insert in this Answer; and therefore the said patents are void and of no effect in law.

25

And for a further and special defense this defendant shows also, that each and all of the said alleged improvements were fully set forth and disclosed in and by the following printed publications, that is to say, in and by each of the Letters-patent enumerated in the foregoing paragraph of this Answer, which were issued from and may be found in the Patent Office of the United States, at Washington, D. C.; and in and by other printed publications whose respective titles, dates, and places of publication, together with the places where the same may be found, and the pagings where such reference may be located, are at present to this defendant unknown, but which it prays leave when discovered to insert in this Answer.

26

And for further and special defense this defendant shows *Fourth*, that this complainant was not the first to produce the alleged improvements and inventions disclosed and purporting to be covered in and by the said Letters-patent and each of them; but that the same had been both known to others and also been produced and used by them long prior to the first alleged production thereof by the said Johnson, as follows:

By Thomas A. Edison, of and at Llewellyn Park, N. J., and elsewhere;
Chichester A. Bell, of and at Washington, D. C., and elsewhere;
Sumner Tainter, of and at Washington, D. C., and elsewhere;

Emile Berliner, of and at Washington, D. C., and elsewhere;
Gianni Bettini, of and at the City of New York, and elsewhere;
Louis S. Clarke, of and at Pittsburgh, Pa., and elsewhere;
John H. White, of and at Washington, D. C., and elsewhere;
Wm. McMahon, of and at Rahway, New Jersey, and elsewhere;
Stewart D. McKelvey, of and at Canton, Ohio, and elsewhere;
Adolph Betzold, of and at St. Louis, Mo., and elsewhere;
Louis P. Valiquet, of and at the City of New York, and elsewhere;
——— Reinhardt, of and at Camden, New Jersey, and elsewhere;
Alfred C. Clark, of and at Philadelphia, Pa., and elsewhere, whose present address is Paris, France,

and others whose names and addresses are to this defendant now unknown, but which when ascertained it prays leave to insert in this Answer, and therefore the said patents are void and of no effect in law.

27

And for a further and special defense this defendant shows *Fifth*, that the matters and things and alleged combinations disclosed in and by the claims of the said Letters-patent and each of them, had been in public use and on sale in this country for more than two years before the date this defendant made application for patent thereon, to wit, by each of the persons named in the preceding paragraph of this Answer, and in addition by the following:

U. S. Gramophone Co., of Washington, D. C., at that place and elsewhere;

Berliner Gramophone Co., of Philadelphia, Pa., at that place and elsewhere;

Universal Talking Machine Co., of New York City, at that place and elsewhere;

National Gramophone Co., of New York City, at that place and elsewhere;

National Gramophone Corporation, of New York City, at that place and elsewhere;

American Talking Machine Co., of New York City, at that place and elsewhere;

Albert T. Armstrong, of New York City, at that place and elsewhere;

Joseph W. Jones, of New York City, at that place and elsewhere,

and others whose names and addresses are at present unknown to this defendant but which when discovered it prays leave of this Court to insert in this Answer; and therefore the said patents are void and of no effect in law.

28

And for a further defense, this defendant shows that in view of the state of the art disclosed by the before-mentioned patents and instances of prior knowledge and public use, the alleged improvements constituting the alleged inventions of this complainant, were at the date of his alleged invention thereof without novelty; and for the same reasons they were without invention; and for the same reasons they were wanting in patentability; wherefore the said patents are void and of no effect in law.

29

And for a further defense, this defendant shows that the apparatus and things dealt in by this defendant were made under and in accordance with improvements invented or discovered or produced by the said Louis

P. Valiquet, or that the same more nearly and closely resembled the said improvements made by the said Valiquet than they resembled the alleged improvements set forth in the patents here in suit; that on Dec. 19, 1898, the said Valiquet filed an application for the grant of U. S. Letters-patent covering his said inventions and improvements; that the said application became involved in interference proceedings with the pending application of this complainant which eventuated into the patents in suit; and that on May 5, 1900, by decision of the highest Tribunal in the Patent Office, reported in Vol. 92 of the Official Gazette of the U. S. Patent Office, pp. 1795–7, it was held that the apparatus and things and combinations set forth and disclosed in and by the said application of Valiquet did not, and could not, come within the terms of the claims of the said pending application of this complainant, which latter subsequently eventuated into the patents here in suit; and it was further decided in the same interference proceedings that the alleged improvements and arrangements set forth and claimed by this complainant (comprising or involving the subject-matter of the claims here in suit) consisted in supporting the diaphragm from the middle rather than from its periphery, and in having the diaphragm free at its periphery both adjacent to the two faces of the gaskets and at its cylindrical edge, —whereas, in the description as originally filed it was expressly stated by the said Eldridge R. Johnson that the said diaphragm was *supported* by the said rubber gaskets, was *held* by them, was under *tension* or *pressure* between the said rubber gaskets, and that there was contact between the said gaskets and the diaphragm; and that there has been no appeal from the said decision in the Patent Office, nor has the same ever been reversed or set aside; for which reasons this defendant avers that the question of infringement of the patents here in suit by the defendant's apparatus is now *res adjudicata* which has been finally decided in the neg-

ative, and the decision acquiesced in by this complainant.

30

And for a further defense this defendant, upon information and belief, avers that the apparatus and matters and things disclosed in and by patent No. 655,557, one of the patents here in suit, and attempted to be claimed by the same, are entirely distinct and separate from the apparatus and matters and things disclosed in and by patent No. 655,556, the other patent here in suit, and attempted to be claimed therein; that the aforesaid things described in the former are not used conjointly with the matters disclosed by the latter of said patents; and that therefore the infringement of the said two patents may not be set up in one Bill of Complaint.

All of which matters and things this defendant is ready and willing to prove as this Honorable Court shall direct, and it humbly prays to be hence dismissed with its reasonable costs and charges in this behalf most wrongfully sustained.

Dated Feb 27, 1901.

Universal Talking Machine Company

by Orville D. LaDow, President.

Waldo G. Morse

Solicitor for Defendant

Office and Post Office Address,

135 Broadway,

New York City.

Philip Mauro

C. A. L. Massie.

~~Philip Mauro,~~

~~C. A. L. Massie,~~

Of Counsel.

LAW OFFICES
HORACE PETTIT
STEPHEN GIRARD BUILDING
PHILADELPHIA

CIRCOUT COURT OF THE UNITED STATES

Southern District of New York.

Patents No.655,556 & 655,557. Suit No.7606.

In Equity.

Eldridge R. Johnson,
Complainant,

vs.

The Universal Talking Machine Company,
defendant.

Please take notice that on Friday May 16, 1902, at a Sessions of Court to be held in the Post-office Building New Yory City, New York, Counsel for Complainant will at the opening of Court, or as soon thereafter as the matter can be heard, make motion to dismiss the Bill of Complaint filed in the above cause, without prejudice. A copy of the Motion is hereto annexed.

Horace Pettit.

Of Counsel for ~~Complainant~~.
Mitchell, Baker & Brownell
Solicitors.

To - Philip Mauro, Esq.,
Waldo G. Morse, Esq.,
Of Counsel for defendant.
New York, N.Y.

May 10, 1902.

~~Due~~ Service of the above notice, and of copy of Motion therein referred to, is hereby acknowledged this 12th day of May 1902.

Waldo G. Morse

Of Counsel for defendant.
Philip Mauro
not of Counsel for Dfdt.

CIRCUIT COURT OF THE UNITED STATES.

Southern District of New York.

Patents No.655,556 & 655,557. Suit No.7606.

In Equity.

Eldridge R. Johnson,
Complainant,

vs.

The Universal Talking Machine Company,
defendant.

M O T I O N.

And now comes the above named complainant, and shows to this Honorable Court that having exhibited his Bill of Complaint in this Honorable Court against the above named defendant, who has appeared by counsel and put in its Answer thereto this complainant is now advised and desires to dismiss his said Bill.

This complainant, therefore, humbly prays that the said Bill may stand dismissed out of this Court without prejudice, with costs to be taxed by the clerk of this Court.

Howe Peters.

Of Counsel for Complainant.

May ,1902.

Whitebeck, Barnes & Brownell
Solicitors

CIRCUIT COURT OF THE UNITED STATES,

SOUTHERN DISTRICT OF NEW YORK,

IN EQUITY.

Eldredge R. Johnson, :

:

-vs- : No. 7606.

:

The Universal Talking Machine Company.:

And now, to wit, this 16th. day of May, 1903, upon motion of counsel for complainant, counsel for both sides being present, and heard, it is

O R D E R E D that the complainants have leave to dismiss their bill of complaint in this case filed without prejudice, and the said bill does hereby stand dismissed without prejudice, to the defendant the costs to be taxed by the Clerk of the Court.

Esthacumbs

U.S.J.